

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUANE E. MENTZE and ROBERT D. VAUGHAN

Appeal 2008-0546
Application 10/116,387¹
Technology Center 2100

Decided: July 8, 2008

Before: JAMES D. THOMAS, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

¹ Application filed April 3, 2002. The real party in interest is Hewlett Packard Co.

Appellants appeal from a final rejection of claims 1 to 27 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to system and method for distributing software, such as printer drivers or software updates, to a number of computers on a network in an efficient manner. In the words of the Appellants:

A system and method for facilitating automated distribution of software is disclosed. The components of a software distribution system cooperatively operated to provide assistance in selecting and locating software compatible with a target system and capable of performing desired functions. A target system automatically formulates a request for software. The software distribution system includes a software description database that supports searches directed at identifying software that is compatible with the request formulated by the target system. The software is stored in a software data repository communicatively coupled to the target system and is capable of forwarding the software to the target system.

(Spec., page 4)

Claims 1 and Claim 11 are exemplary:

1. A software distribution system comprising:

a software description database that supports searches that identify software that is compatible with a query for said software;

a target system coupled to said software description database, said target system automatically formulates said query indicating desired software parameters for said software; and

a software data repository coupled to said target system, said software data repository stores said software and is capable of automatically selecting and forwarding said software compatible with said desired software

parameters to said target system and descriptive information to said software descriptive database, without intervention by a user.

11. A software distribution method comprising:
 - determining required software attributes automatically;
 - identifying software compatible with said required software attributes; and
 - selecting and forwarding said software compatible with said required software attributes automatically, without intervention by a user.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Davis	US 5,742,829	Apr. 21, 1998
Cole	US 6,074,434	Jun. 13, 2000
Feinman	US 6,075,943	Jun. 13, 2000
Halpern	US 6,282,711 B1	Aug. 28, 2001
Crespo	US 6,854,112 B2	Feb. 8, 2005

Rejections:

- R1: Claims 1 to 3, 6, 7, 11, 18, 22 and 23 stand rejected under 35 U.S.C. 103(a) for being obvious over Halpern in view of Cole.
- R2: Claims 1 to 9, 11, 14 to 20, and 22 to 26 stand rejected under 35 U.S.C. 103(a) for being obvious over Cole.
- R3: Claims 10 and 27 stand rejected under 35 U.S.C. 103(a) for being obvious over Cole in view of Feinman.

R4: Claims 12 and 13 stand rejected under 35 U.S.C. 103(a) for being obvious over Cole in view of Davis.

R5: Claim 21 stands rejected under 35 U.S.C. 103(a) for being obvious over Cole in view of Crespo.

Appellants contend that the claimed subject matter is not rendered obvious by Cole alone, or in combination with Halpern, Feinman, Davis or Crespo, for failure of the references to teach claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. We consider in this opinion only those arguments that Appellants actually made in the Briefs. All other arguments are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether there the references teach the automatic forwarding of software as claimed, and other limitations.

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system and method for distributing software to one or more target systems without requiring the user to determine the parameters of the software required by their systems and individually load the correct software. (Spec. p. 3, l. 20). The software to be loaded is stored on a Software Data Repository. (#140, Figure 1). Descriptive information concerning the software, including information about which versions would be appropriate for an individual target system, are stored on a Software Description Database. (#130, Figure 1). To implement a software distribution, a component (#115) in the target system first sends a request to the Software Description Database specifying the parameters of the required software, and receiving back to the target system information designating the version of the matching software that the target should request from the Software Data Repository. (Spec., p. 9). The target system then retrieves that correct version of the software from the Software Data Repository. Meanwhile that Repository sends descriptive information to the Software Description Database to keep its information current.
2. The patent reference Cole teaches a method and system for updating software or data on various client computers (Fig. 1, #14, 15 and 16) connected by a network without the user having to determine the detailed parameters of the software. The software to be loaded on those target computers is stored on a content server #17, with metadata describing the

various versions and addresses of the software stored on selection server #12. (Col. 3., ll. 33 to 46). When the software is to be updated, the client downloads a recognizer program #41 (col. 4., l. 26) that sends a detailed description of the client's software parameters (e.g. operating system, BIOS) back to the selection server 12. The selection server comprehends which version of the software upgrade is appropriate for that particular client based on the metadata about the software that is stored on the selection server 12. (Col. 4., l. 50). The selection server then puts together a few choices of matching software (e.g. full update, partial update, etc.) all compatible with the client computer, and presents it to the client computer. Based on the choice of downloads, the client then downloads the proper software upgrade as desired. (Col. 7, l. 8).

3. The Halpern patent is also addressed to a system for distributing software to a number of client computers over a network. The user initiates the process by engaging in a dialog with a user interface of an options manager, (Figure 1, #104). Based on meta data from a component information database (#106) the correct software is packaged for a download from an installer (#109) and customized to be operational on the client computer. The software is compressed and ready for extraction at the client. (Col. 6, l. 12).
4. Secondary references Davis, Feinman and Crespo are all also patents engaged in the process of automatic software distribution over a network.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732 (2007).

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, "there must

be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a *prima facie* case for the rejection of Appellants’ claims under 35 U.S.C. § 103. The *prima facie* case is presented on pages 3 to 25 of the Examiner’s Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection under 35 U.S.C. § 103(a) over Cole alone [R2]

We start our analysis with the rejection of claims 1 to 9, 11, 14 to 20, and 22 to 26 for being obvious over Cole alone.

Appellants argue (Br., p. 15, bottom) “that nowhere does Cole teach or describe a system which will automatically select and forward software compatible with the desired software parameters to a target system.” Specifically, “Cole does *not* show automatic forwarding of software. Instead, Cole makes available a list of updates... from which a user makes a selection, before any software is transmitted to the target system.” (Id.).

The sequence of events as described in the patent (col. 7, l. 17) indicates that after the user chooses his update, the selection server #12 then sends addressing information to the client #14 (called the target in the claim), and the downloading routine #39 of the target then downloads the updates directly from the content server #17. Everything in the reference is automatic after the user selects his choice of full or partial update. [FF#2]. The question under 35 U.S.C. § 103 is not whether the claim is anticipated, but rather whether the prior art renders the claim obvious. Cole distributes the same type of software in just about the same way as claimed, however Cole pauses to ask the user a question. Would it have been obvious to skip the question, and just download the software update? We conclude that it would have been obvious. Offering the choice of a full or a partial update is an extra feature provided by Cole, and one which could easily be skipped. In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731 (2007) the Supreme Court indicates “A court must ask whether the improvement is more than a predictable use of prior-art elements according to their established functions.” We find that omitting the extra feature of choice yields a very predictable result, namely a download without user attention.

The Examiner has presented supplemental reasons for holding this limitation obvious over the prior art. (Ans., pp. 33 and 34). We would also proffer that “automatically” and “without intervention by a user” are terms that may be construed broadly. As an example of the breadth of the term “automatic”, we note that a transmission is deemed automatic, shifting gears

without user intervention, even though a user must first place the control lever into Drive to actuate that feature. Thus, some manual action may be used even in an automatic device.

Appellants further argue, with respect to Claim 18, that Cole “fails to teach or describe a process which includes automatically extracting descriptive information from a software data repository, as claimed.” (Br., p. 16, top). Claim 18 is a bit broader than claim 1 which we analyzed just above. The phrase from Claim 18, “automatically extracting descriptive information from a software data repository;” is read by the Examiner on the extracting of data for Cole’s software list in preparation for its presentation to the user. (Ans., p. 34, middle). We do not find error in this interpretation, as the breadth of claim 18 does not distinguish between the software descriptive database and the software data repository. The Examiner further reasons that it would have been obvious to provide meta data for normal updates in Cole, as he expresses in the Answer, page 35, top. Additional to the Examiner’s arguments, however, is a statement in Cole, column 3, lines 53-54, stating “The code updates remain stored in the content server, but the meta data is written to the selection server, either via the Internet or by manual loading.” This suggests to this Board the teaching that the meta data may be automatically extracted over the Internet from a data repository (content server), as opposed to being manually loaded.

In view of the above reasoning, we conclude that Appellants have not shown that the Examiner erred in rejecting the claimed invention over Cole alone. [R2]

*Arguments with respect to the rejection
under 35 U.S.C. § 103(a) [R3][R4] and [R5]
over Cole in view of Feinman, Davis and Crespo*

With regard to the rejections of claims 10 and 27 [R3], 12 and 13 [R4] and 21 [R5], Appellants have relied on arguments concerning alleged defects in the rejection over Cole alone [R2], and have stated merely that Feinman, Davis and Crespo fail to correct these defects. (Br., pp. 17 to 20). Since we do not concur that the Examiner has erred in the rejection over Cole alone, we decline to find error in these rejections.

*Arguments with respect to the rejection
under 35 U.S.C. § 103(a) [R1]
over Halpern in view of Cole*

The Examiner has rejected claims 1 to 3, 6, 7, 11, 18, 22 and 23 for being obvious over Halpern in view of Cole under 35 U.S.C. § 103(a). Appellants contend that “Neither Halpern nor Cole, therefore, describe the operation of a software distribution system in which a software data repository is capable of automatically selecting and forwarding software to a target system compatible with said desired software parameters, and forwarding descriptive information to a software descriptive database without intervention by a user, as claimed.” (Br., p. 11, bottom).

This issue with regard to each of these noted claims has been explored in detail above with respect to the rejection over Cole alone. In accordance with the holding of *In re Bush*, (cited above), we need not reach an

independent conclusion on the combination of Cole and Halpern furthering the rejection of these claims, but may rely on affirming the rejection as stated.

Appellants further argue that Halpern and Cole may not be properly combined. (Br., p. 13, top). As both of these references are drawn to the same field of endeavor (see Findings of Fact #2 and #3 above), they may be properly combined in a rejection under 35 U.S.C. § 103. (See *In re Clay* cited above.)

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 1 to 27 under 35 U.S.C. § 103.

DECISION

We affirm the Examiner's rejections of claims 1 to 27.

Appeal 2008-0546
Application 10/116,387

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400